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EXAMINER

MOISE, E

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Application/Control Number: 08/510,740

Art Unit: 2133

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Supplemental Examiner's Answer

This case has been remanded to the Examiner for reconsideration of the 35 U.S.C. 101 non-statutory rejection of claims 1-4 of the present application in view of the recent decisions by the Court of Appeals for the Federal Circuit in State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), cert. denied, and AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir.), cert. denied, 120 S. Ct 368 (1999).

Reconsideration of 35 U.S.C. 101 rejection of claims 1-4 in view of the above recent decisions

In State Street Bank & Trust Co. v. Signature Financial Group, 47 USPQ2d at 1601, it was held that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces “**a useful, concrete and tangible result**” where the useful, concrete and tangible result represents a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades. Emphasis added.

Similarly, in AT&T Corp. v. Excel Communications, Inc., 50 USPQ2d at 1452, the claimed method for producing message record for long distance telephone calls, enhanced by addition of primary interexchange carrier (PIC) indicator was found to be statutory subject matter even though PIC indicator value is derived using simple Boolean mathematical principle, because

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the claimed process applies Boolean principle to produce a **“useful, concrete and tangible result”** where the useful, concrete and tangible result, the PIC indicator value, represents a useful, non-abstract result that facilitates differential billing of calls made by subscriber to long distance carrier. Emphasis added.

In the present case, the quotient generated by implementing the mathematical steps of claims 1-4 does not represent a **“useful, concrete and tangible result”** in the sense of State Street Bank & Trust Co. v. Signature Financial Group and AT&T Corp. v. Excel Communications, Inc. because the mathematical algorithm included within the process claims is applied to produce a number which has no specific meaning. A result obtained from the application of an algorithm was held to be a **“useful, concrete and tangible result”** because it represents the condition of a patient's heart. See Arrhythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Circ. 1992). Treating the quotient generated by the mathematical algorithm of claims 1-4 of the present case as a **“useful, concrete and tangible result”** would not be consistent with the above holdings.

For the foregoing reasons, the examiner contends that the holdings in “Street Bank & Trust Co. v. Signature Financial Group” and “AT&T Corp. v. Excel Communications, Inc.” do not affect the 35 U.S.C. 101 rejection of claims 1-4 of the present application as set forth in the Examiner's Answer (paper #15).

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Emmanuel L. Moise

Primary Patent Examiner
Art Unit 2133

May 17, 2001